

### **REMARKS/ARGUMENTS**

The office action of January 5, 2004 has been carefully reviewed and these remarks are responsive thereto. By the present amendment, Applicants have added new claims 23-27. Claims 1, 3-8, 10, 12-17, 19 and 21-27 thus remain pending after entry of the present amendment. Reconsideration and allowance of the instant application are respectfully requested.

#### ***Rejections Under 35 U.S.C. § 103***

Claims 1, 3-8, 10, and 12-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung *et al.* (U.S. Pat. No. 6,570,583 B1, hereinafter Kung) in view of Williams *et al.* (U.S. Pat. No. 5,542,138, hereinafter Williams). Applicants respectfully traverse this rejection for at least the following reasons.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, Applicants maintain that there is no motivation to combine Kung with Williams. Kung describes a zoom-enabled handheld device that has a zoom control device for generating a zoom control signal. A display program, held in memory, will change the font size of displayed text or icons according to the zoom control signal. See Kung, Title and Abstract. However, the Kung device, as discussed above, places the zoom and panning controls on the same side of the device as the display screen.

Williams, on the other hand, describes a unit for a hospital bed, not even remotely related to handheld devices such as are described in Kung. In addition, Williams does not provide a zooming or panning control on either a front or back side of the device. To the contrary, the Williams device must be *opened* in order to expose the controls referred to by the Office Action.

In addition to arguments previously made by Applicants, when the Williams device is the open configuration, *the controls on the back of the device do not affect content displayed on the*

*display screen on the front of the device.* That is, the controls on the back of the Williams device when it is in the open configuration control head and knee positions on a mattress, mattress firmness, volume and channel on a television, and call a nurse, and are not intended for use when the user is using the display screen above the keyboard. The control that manipulates content on the display screen above the keyboard is a trackball located on the same side as the display screen. See Williams, Fig. 3, No. 74.

Furthermore, the Office Action does not provide any suggestion or motivation to combine the two references. The Office Action improperly cites a result of the combination as a motivation to combine the references in the first place by stating that it would be obvious to combine the references "in order to allow entry of patient data into the control module which can subsequently be viewed on the display." Even if that is true, it is impermissible hindsight and, even if it were not impermissible hindsight, it is not what is claimed. The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). There is no motivation to combine these references, and even if the two references were combined, the combination would have redundant controls on the front of the device for controlling content on the display screen and irrelevant controls on the back.

Thus, based on the above arguments, Applicants respectfully submit that that there is no motivation or suggestion to combine Kung, which describes a zoom-enabled handheld device, with Williams, which describes a remote control device. Should the Office maintain this rejection, the examiner is respectfully requested to provide a suggestion or motivation within the references themselves, or provide evidence of the level of knowledge of one of ordinary skill in the art, that would support such a combination.

In addition, even if Kung were combined with Williams, the combination does not teach or suggest placing first and second user input controls on the housing on the back of the device that manipulate content on the display screen, and placing the display screen on the front of the device. The device in Williams must be opened in order to expose any controls on a back side of

the device from the display screen, and *the controls on the back side do not control content on the display screen on the front of the Williams device*. Thus, the rejection of claims 1, 3-8, 10, and 12-17 is respectfully traversed.

In addition, with respect to independent claims 1 and 10, even if the two references are combined, they do not teach or suggest all the claim limitations. As discussed above, *the controls in Williams cited as being on the back of the device from the display screen do not manipulate content on the Williams display screen on the front of the device*. This is a fatal defect in the Office Action's combination. Combining Kung with Williams, assuming they can be combined, which Applicants maintain they cannot, results in a device that has multiple redundant controls on the front of the device for manipulating content on the display screen, which is also on the front of the device, and has controls on the back of the device for controlling head and knee positions on a mattress, mattress firmness, volume and channel on a television, and calling a nurse. The combination does not result in a device as claimed in claim 1 comprising:

- a display screen on the front of the device;
- a first user input control on the back of the device, wherein the first user input control detects a direction of first user input;
- and
- a second user input control on the back of the device, wherein the second user input control detects a direction of second user input;
- wherein, when user input is received through the first user input control, content on the display screen is panned in a direction responsive to the detected direction of the first received user input,
- and
- wherein, when user input is received through the second user input control, content on the display screen is zoomed in or out responsive to the detected direction of the second received user input.

Nor does the combination result in a method as claimed in claim 10 comprising:

- (i) when first user input is received through a first user input control capable of detecting a direction of user input, panning content on a display screen in a direction responsive to the detected direction of the first user input, and

(ii) when second user input is received through a second user input control capable of detecting a direction of user input, content on the display screen is zoomed in or out responsive to the detected direction of the second user input,  
wherein first and second user input controls are located on the back of the device,  
and wherein the display screen is located on the front of the device.

Dependent claims 3-8 and 12-17 are allowable based on the allowability of their respective base claims. In addition, with respect to claims 8 and 17, the combination of the two references does not teach or suggest "wherein the first and second controls are each located in a position that, when a user is holding the device with both hands on either side of the display screen, enables the user to manipulate one control with the user's right hand and one control with the user's left hand" as claimed. Specifically, the controls in Williams are not reachable by a user's hands when a user is holding the device with both hands on either side of the display screen.

Claims 19, 21 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kung in view of Conway *et al.* (U.S. Pat. No. 5,278,779, hereinafter Conway) in view of Wang (U.S. Pat. No. 5,771,038). This rejection is respectfully traversed.

Neither the references nor the Office Action states a valid suggestion or motivation to combine the cited references. Instead, the Office Action again improperly cites the result of the combination as a motivation to combine the references in the first place, and this is again impermissible hindsight. Applicants respectfully submit that claims 19, 21 and 22 are also allowable for similar reasons as claim 1, namely, that even if combined, the combination does not teach or suggest all the claim limitations, including "a display screen on a front side of the housing; a first touch pad attached to a back side of the housing; and a second touch pad attached to the back side of the housing;..." as recited in claims 19, 21, and 22.

***New Claims***

New claims 23-27 have been added. Claims 23-27 are supported by the specification as originally filed. No new matter has been added. The new claims are allowable at least because not of the cited references, alone or in any combination, teach or suggest input controls located on an opposite side of the device from the display screen as claimed.

***Remarks Regarding Examiner's 'Response to Amendment'***

Applicants respectfully request clarification regarding the 'Response to Amendment' at pp. 8-9 of the Office Action. Specifically, the Response to Amendment indicates it is responsive to Applicants' arguments filed August 29, 2003. However, Applicants subsequently filed a Response on December 15, 2003. In addition, Applicants respectfully point out that the Office Action's characterization of Applicants' arguments is improper and incorrect. Namely, Applicants have made no admissions with respect limitations of claims being met if Williams' remote control is opened. To the contrary, as argued above, even if the Williams device is in the open configuration, and even if the Williams device is combined with the Kung device, the combination does not teach or suggest all the limitations of any claim.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.


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Respectfully submitted,

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